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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,678	01/26/1999	STEVEN R. CLARKE	CRS/227	6023

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EXAMINER

SINGH, ARTI R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/238,678

Applicant(s)

CLARKE, STEVEN R.

Examiner

Ms. Arti Singh

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. The Examiner has carefully considered Applicant's amendments and accompanying remarks filed on 10/15/2002 and 02/14/2003. Applicant's amendments to claims 1, 2, 7, 9 and 10, and to the specification have all been entered. The amendments overcome the objections/rejections in paragraphs 1-5 in the previous office action (paper no. 3), and are thus withdrawn. Applicant's arguments that the Venable reference does not teach the protective layer to be resistant to bituminous adhesives are persuasive, and the rejections made in paragraphs 6-12 of the previous office action (paper no. 3) are also withdrawn.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Harkness (USPN 4,755,409). Harkness discloses a waterproofing laminate comprises a reinforcing sheet, first bitumen layers secured to the surfaces of the reinforcing sheets, first and second compound bitumen layers secured to the first and second bitumen layers, an elastomeric sheet secured to one of the compound bitumen layers and a release sheet secured to the other. Removal of the release sheet permits the waterproofing laminate to be secured to a surface to be protected (column 1, lines 60-70). As is shown in the FIGURE, a reinforcing sheet 2 has layers of bitumen 4, 6 secured to opposed surfaces thereof. Layers of compound bitumen 8, 10 are secured respectively to the bitumen layers 4, 6. An elastomeric sheet 12 is

Art Unit: 1771

secured to compound bitumen layer 10 and release sheet 14 is secured to compound bitumen layer 8. It is contemplated that the elastomeric sheet 12 will be exposed to the elements when the laminate is secured to a roof, floor or other building component. Application to the surface is made by removing release sheet 14 thereby exposing compound bitumen layer 8, which may then serve as an adhesive to bond the laminate to the surface to be protected. The elastomeric sheet preferably has certain characteristics including properties, which resist bitumen attack (column 2, lines 45-59). In general, it will be preferred that the elastomeric sheet 12 contain a material selected from the group consisting of polyisobutylene, chlorinated polyethylene, natural rubber, polyvinyl chloride and ethylene vinyl acetate. Ethylene propylene diene copolymer may also be used. A specifically preferred formulation for the elastomeric sheet 12 includes about 10 to 40 percent by weight of unplasticized polyvinyl chloride, about 10 to 40 percent by weight of an ethylene vinyl acetate carbon monoxide terpolymer and about 5 to 35 percent of coal tar pitch. The elastomeric sheet may also contain up to about 30 percent of particulate filler, up to about 25 percent of fibrous filler and up to about 15 percent primary or secondary plasticizer with or without up to about 10 percent of processing aids or stabilizers (column 2, line 63- column 3, line ). The reinforcing sheet 2 may be selected from those which have come into common use for the ordinary bituminous roof membrane such as a glass fleece or non-woven fabric composed of synthetic fiber as well as previously known material such as paper, felt, fabric or cloth composed of organic or inorganic fiber such as, for example, rag felt, asbestos felt, cotton fabric or jute cloth. Generally when fibrous sheets are used they are impregnated with molten bitumen in order to seal the voids therein before the reinforcing sheet 2 is subjected to coating with molten bitumen. The reinforcing sheet 2 may also be provided from synthetic polymer film or metal foil such as aluminum foil or copper foil. When such film or foil is used

Art Unit: 1771

the pre-impregnation treatment with bitumen is not necessary. If desired, suitable physical or chemical treatment as by sandblasting, etching or the like may be provided to establish a good affinity with bitumen before subjecting the reinforcing sheet 2 to a layer of molten bitumen. The reinforcing sheet 2 is covered on one surface or both surfaces with bitumen and all or part of the bitumen coated layer is laminated with compound bitumen that may be denatured bitumen prepared to impart high tackiness at ambient temperature as a result of blending of the same with natural or synthetic rubber or natural or synthetic resins or both. It is preferred that the layers of bitumen and layers of compound bitumen be applied in the form of a coating with the former having a thickness of about 0.001 to 0.015 inch and preferably about 0.0025 to 0.007 inch and the latter having a thickness of about 0.001 to 0.015 inch and preferably 0.0025 to 0.007 inch. In applying the laminate to a roof, floor or other structure one need merely remove the release paper 14 thereby exposing the compound bitumen layer 8 permitting the adhesive compound bitumen 8 to be applied in surface-to-surface contact with the surface to be protected. With the application of slight pressure, the installation is complete.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 703-305-0291. The examiner can normally be reached on M-F 8:00am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-873-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application/Control Number: 09/238,678

Page 5

Art Unit: 1771

A handwritten signature in black ink, appearing to be 'AS' with a stylized flourish.

Ms. Arti Singh  
Patent Examiner  
Art Unit 1771

ars  
May 5, 2003